



PATENT

ATTORNEY DOCKET NO. 114596-07-4014

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/330,852 Confirmation No.: 9904
Applicant: David L. Reese, et al.
Title: PROFILING RANGES OF EXECUTION OF A COMPUTER PROGRAM
Filed: June 11, 1999 Art Unit: 2193
Atty. Docket: 114596-07-4014 Examiner: J.Q. Chavis

CERTIFICATE OF MAILING (37 C.F.R. § 1.8a)

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- Return postcard
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- Form PTOL-85 Part B
- Response to Notice of Allowance
- Conditional Supplementary Amendment Provisionally Refiled Under 37 C.F.R. § 1.312
- Request for Refund

(along with any paper(s) referred to as being attached or enclosed) are being deposited with the United States Postal Service on the date shown below with sufficient postage as first-class mail in an envelope addressed to Mail Stop Issue Fee, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Respectfully submitted,

WILLKIE FARR & GALLAGHER LLP

Dated: August 1, 2006

By: 

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RESPONSE TO NOTICE OF ALLOWANCE

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Applicant responds to the Notice of Allowance of May 2, 2006 as follows.

I. The "Conditional Supplementary Amendment" of November 30, 2006 Should be Entered

The status of the "Conditional Supplementary Amendment" of November 30, 2005 is not indicated in the record. This amendment should already be entered; Applicant requests either confirmation or entry under Rule 312.

In the interview of March 28, 2006, the Examiner raised a "new ground of rejection." See Examiner's Interview Summary dated 4/24/2006. This "new ground" caused finality of the Office Action of September 30, 2005 to be vacated. Because finality was vacated, the "Conditional Supplementary Amendment" of November 30, 2005 was entitled to entry as a matter of law.

I certify that this correspondence, along with any documents referred to therein, is being deposited with the United States Postal Service on August 1, 2006 as First Class Mail in an envelope with sufficient postage addressed to Mail Stop Issue Fee, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

In the alternative, the "Conditional Supplementary Amendment" is refiled herewith as a Rule 312 Amendment.

The amendment is not narrowing.

II. Comments on Examiner's Reasons for Allowance

The Examiner's Statement of Reasons for Allowance states that "the closest prior art reference is the patent to Reese at al.," referring to U.S. Pat. No. 6,941,545. This is not correct: the Reese '545 patent is not "prior art," it is only a commonly-owned patent with a common priority date. If the Examiner's Statement is simply a misstatement, no further action is required. If the Examiner was under the impression that the Reese '545 patent was in fact "prior art," Applicant requests that the application be reconsidered to clarify that all claims are patentable.

The Statement of Reasons for Allowance misparaphrases several of the interrelationships recited in the claims. For example, claims 1, 2 and 24 do not recite "indicating the last byte" as stated in the Reasons for Allowance. Rather, they state "recording ... the address of the last byte." MPEP § 1302.14 instructs that "Care must be taken that [reasons for allowance] do not place unwarranted interpretations, whether broad or narrow, upon the claims." The Examiner's rephrase of claims is entitled to no weight.

As noted by the Statement of Reasons for Allowance, each claim recites at least one element that is absent from the closest reference. The combination of limitations recited in each claim is also absent from any proper combination of the references. Applicant reserves the fight to establish patentability for other reasons in the future. *TorPharm Inc. v. Ranbaxy Pharmaceuticals Inc.*, 336 F.3d 1322, 1330, 67 USPQ2d 1511, 1517 (Fed. Cir. 2003).

III. Request for Refund of Fees Paid in Excess of the Amount Required

A request for refund of excess extension fees is filed herewith.

IV. Conclusion

Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance

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the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance.

Applicant believes this paper occasions no fee. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 23-2405, Order No. 114596-07-4014.

Respectfully submitted,

WILLKIE FARR & GALLAGHER LLP

Dated: August 1, 2006

By: 

David E. Boundy
Registration No. 36,461

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